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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,407	03/09/2006	Rory Lee Block	47079-00234USPX	6631
70243	7590	11/24/2009	EXAMINER	
NIXON PEABODY LLP			HSU, RYAN	
300 S. Riverside Plaza			ART UNIT	
16th Floor			PAPER NUMBER	
CHICAGO, IL 60606			3714	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/571,407	<b>Applicant(s)</b> BLOCK ET AL.	
	<b>Examiner</b> RYAN HSU	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/17/09; 6/11/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

In response to the amendments filed on 7/19/09, no claims have been amended. Claims 1-22 are pending in the current application.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 10, 15, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres et al. (US 6,319,125 B1).**

Regarding claims 1, 10, and 18, Acres teaches a method of operating a wagering game comprising storing data in at least one database where the data is used for operating a wagering game. Additionally, Acres teaches receiving at a gaming terminal a player card that includes various media to provide information to the gaming terminal to be compared so that different functions might occur at the gaming terminal device (*see col. 4: ln 20-60*). While Acres' does not specifically teach a first function in comparison with a first media and a second function in comparing a second media the operation of player identification cards would store information in the memory storing data that would provide the gaming server to determine the player's eligibility for different awards and prizes (*see col. 5: ln 65-col. 6: ln 67*). As discussed in Acres' the player tracking card provides historical game play data of the specific player that will qualify the player for different progressive prizes and 'mystery' bonuses (*see col. 7: ln 10-21*). The player card has become an old and well known device in the gaming arts to allow a wagering

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game and operator to track the movements and data with respect to a player. It is interpreted by the Examiner that the player cards that are able to serve as multi-functional devices (*ie: player account credits, bonus' earned, player points, player eligibility, registered information to identify players*) comprise of information to be stored in fields. In order to achieve these functions, player cards used by the system of Acres' must incorporate media that is able to store data and within that data storage medium a plurality of distinct type of fields would exists referring to different functional responses dependent upon the stored information of those memory fields. The concept described above about player cards is old and well known in the gaming arts and the examiner takes OFFICIAL NOTICE that various types of information are stored on a player card to enact several functions on one multi-purpose card (*ie: Sarbin (US 5,179,517) which discloses a plurality of memory modules incorporated into one player card*). One of ordinary skill in the art at the time the invention was made would recognize the various memory modules or fields used in the player card of Acres to be an art equivalent to that of the claimed invention. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that the player card of Acres is a card that includes a first media and second media distinct (*ie: separate fields*) that provides information to the gaming terminal and performs a first function in response to comparing information on the first media and a second function in response to the information on the second media.

Regarding claims 2-4, 15, and 19-20, Acres teaches a method wherein the first function relates to tracking a player and the other determining access to a restricted-access progressive game (*see col. 5: ln 65-col. 6: ln 67*).

**Claims 5-9, 11-14, 16-17, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres as applied to claims above, and further in view of Criss-Puszkiewicz et al. (US 2002/0155887 A1).**

Acres teach all the elements as discussed above, however is silent with respect to the specific structure and security embodied in player identification cards.

In several different gaming patents the structure of player identification cards are taught. These various gaming patents, teach the media to store information on the tracking card to be in the form of magnetic strips, barcodes, or signals (ie: smart cards). Additionally, providing more than one bar code or magnetic strip would produce the expected result of storing information in different fields and would only require one of routine skill in the art. It provides no unexpected result and is but a listing of the available mediums well known in the gaming arts to be used on player tracking cards. These different mediums are recognized in the art as being art unit equivalents from one another. The underlying principles exploited by these media are to store information that is to be used by a gaming server to evaluate the specific parameters of a player's account. The prior art of record teaches that this can be done using one barcode (Luciano et al. US 6,500,067), magnetic strip or signal therefore making the two 'media' separate would only take routine skill in the art. These different media are also available to store information and data to be used by the gaming machine terminals and the gaming servers to identify and track player information. Duplicating such a media would only produce the expected result of providing more storage space on the player tracking card. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to duplicate and produce a second medium on a player tracking card. Furthermore, producing a player card with two

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different types of medium (ie: a mag strip, barcode combination) would provide the expected result of enabling a card to be read by a plurality of different readers and therefore would produce the expected result of allowing a player identification card to be mated with more reading devices. Therefore it would have been obvious to one of routine skill in the art at the time the invention to provide the modification of including two distinct types of medium on a player tracking card.

In a related gaming patent, Criss-Puskiewicz et al. teaches a player tracking system that incorporates a card that identifies a player using either a magnetic strip card or a signal which is read and provides the system with the player's information.

Regarding claims 5-9, 11-14, and 22, Criss-Puskiewicz teaches a method wherein first and second media use a security device to indicate information to the system. This media can be in the form of bar codes, magnetic strips, or frequency identification signals (*see abstract, Fig. 6 and the related description thereof*).

Regarding claims 16-17 and 21, Criss-Puskiewicz teaches a gaming terminal wherein the two media are capable of being on the same side of the single game card and at least one reading component includes two reading components (*see Fig. 6 and the related description thereof*).

Thus one would have been motivated to incorporate the features of Criss-Puskiewicz in order to provide the structure of a player tracking card that was adaptable to more than one type of card reading device. Therefore it would have been obvious to one of ordinary skill in the art to implement the player tracking card of Criss-Puskiewicz with that of the system taught in Acres at the time the invention was made.

### ***Response to Arguments***

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1. Applicant's arguments filed 7/16/09 have been fully considered but they are not persuasive.

2. **Section I:**

3. The applicant argues that with the prior art of record does not teach, suggest, or disclose the limitations set forth in independent claims 1, 10, and 18. Specifically the applicant's representative argues that the prior art fails to require "using information from the first media to identify the "player in a first database; and using information from the second media to identify the player from the second database". Examiner respectfully disagrees. The player card of Acres' teaches that it is used on a gaming terminal that will then identify the player. The information stored on the medium then identifies the player and uses that various information stored on the card to link up to player server and then provide the function of identifying the player. The information is read into the gaming machine using the MCI (machine communication interface) which is interfaced to several peripheral components for displaying bonus amounts, greeting messages, instructions, anticipation messages and other information (*see col. 20: ln 15-30*). The card is also capable of storing information to relate to player bonus information and player eligibility. The different features provided by the player card of Acres is not an exhaustive list but simply demonstrative of the various functions that are related to the media and information stored on the player card. It is in view of these observations that the limitations that the limitations have been met.

4. Furthermore, the observations made by the Examiner are not mere conclusory and self serving statements with respect to the first and second media as attested to by the applicant's representative. The Examiner has stated the broadest reasonable interpretations for the player

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cards well known in the gaming arts. The Examiner will explain the position through the use of the following hypothetical situations. From a higher level perspective, if two medias are to be distinguishing elements one barcode and a second barcode, then the instant invention would quite frankly be a duplication of parts. Using a second barcode to identify store information to produce a function is the basic premise of using the media on a player card in the first place. Information is stored on the media and then utilized by the gaming system to identify the player (*ie: the function*). Furthermore, player cards with one magnetic strip media are capable as shown above of producing several functions at the same time. Producing a second media on a player card provides the expected result of increasing the amount of information stored or is a redundant attribute. The applicant has not provided any benefit or unexpected improvement by the incorporation of duplicating a media on the player card. Alternative, if looking at a lower level, memory is segmented into different modules or segments. Each segment or module stores different types of information and therefore a multifunctional card contains different segments of memory or fields that store the information to be used by the player card. While such a tactic is inferred upon in the use of Acres' player card, the explained principle and method is present in any networked device or protocol and an elementary concept in the utilization of memory.

5. With respect to the applicant's characterization of the first database and second database of the independent claims, the Acres' patent teaches the card to access and retrieve information using the gaming server, player, server and bonus servers. Each of these servers are equivalent to databases as if they are capable of retrieving the information they are accessing it from "a structured set of data held in a computer" or otherwise a database. They are characterized as an



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server because they have the added functionality of managing the network communication between the various connected electronic gaming machines.

6. ***Section II: The pending rejection fails to present single motivation or apparent reason why a person in the art would modify Acres' as proposed by the Examiner.***

7. The Examiner respectfully disagrees with the characterization. The Examiner has provided several motivations for modifying the prior art of Acres'. Firstly providing multiple different types of media allows the player card to be read by more various types of card readers so that a player could access a gaming machine regardless of the type of reader it uses.

Alternatively the second media is a duplicate part and one would be motivated to incorporate a second media if the information necessary to be stored was larger than the physical limits that could be stored on a first media. Under these various motivational statements and explanations that have been provided in the response to applicant's arguments as well as the rejection above, the applicant's remarks are not persuasive and the rejection has been upheld above.

8. ***Section III: 103(a) rejections fail to adequately articulate the grounds for rejection.***

9. In the examples provided by the applicant's representative, Acres teaches a restricted-access progressive game" (ie: *player eligibility, see col. 15: ln 35-col. 56*), personal wagers (restricted to only the respective player, *see col. 38: ln 20-col. 39: n 36*). Additionally, the rejection of a two media card on a single game card has been reiterated in Section I and II above.

10. With respect to using information from the first media to identify the player in a first database and using information from a second media to identify the player in a second database has also been discussed and reiterated in second I and II above.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN HSU whose telephone number is (571)272-7148. The examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Primary Examiner, Art Unit 3714

RH  
November 21, 2009